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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,219	02/11/2004	Masafumi Hayashi	DAIN:645A	9997
25944	7590	05/05/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/775,219

Applicant(s)

HAYASHI ET AL.

Examiner

Kimberly K. McClelland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-26, 28 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 36-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/11/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19 and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 19 recites the limitation "the thermally transferable protective layer" in 16.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19, 36, and 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,312,788 to Mohri et al.
5. With respect to claim 19, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (See MPEP 2114). Mohri et al. discloses a

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receiving sheet, including a substrate sheet (41), a thermally transferable release layer formed on the substrate, the release sheet having a single or multi-layer structure (43), and a thermally transferable protective layer formed on the thermally transferable release layer, the thermally transferable protective layer having a single or multi-layer structure, and comprising a thermoplastic resin having a storage modulus at 110°C of  $1 \times 10^5$  Pa or less (44, see Figure 1b, column 7, lines 31-36, and column 18, lines 3-7).

6. As to claim 36, Mohri et al. discloses the substrate sheet is formed of a plastic film having a thickness from 2 to 100  $\mu\text{m}$  (column 9, lines 14-22).

7. As to claim 38, Mohri et al. discloses a portion of the transfer sheet to be transferred provides a coverage of 3 to 30  $\text{g/m}^2$  (column 30, lines 27-29).

8. As to claim 39, Mohri et al. discloses the thermoplastic resin has a Tg value of 40°C to 100°C (i.e. polyvinyl chloride, column 9, lines 26-33).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,312,788 to Mohri et al. as applied to claims 19, 36, and 38-39 above, and further in view of U.S. Patent No. 5,726,122 to Saito et al.

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11. With respect to claim 37, Mohri et al. discloses a receiving sheet, including a protective layer (42). However, Mohri et al. does not disclose a glossiness value for the transfer sheet. Saito et al. (5,726,122) discloses the plastic film has a glossiness at 45 degrees of 100% or less (See Example B-1, Table 6, and column 28, lines 53-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the glossiness measurement of Saito et al. (5,726,122) with the receiving sheet disclosed by Mohri et al. The motivation would have been to form images that are clear and excellent in transparency (column 1, lines 38-39). Therefore, it would have been obvious to combine Saito et al. (5,726,122) with Mohri et al. to obtain the invention as disclosed in claim 37.

12. Claims 40-41, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,312,788 to Mohri et al. in view of U.S. Patent No. 6,346,316 to Saito et al.

13. With respect to claim 40, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (See MPEP 2114). Mohri et al. discloses a receiving sheet, including a substrate sheet (41), a thermally transferable release layer formed on the substrate, the release sheet having a single or multi-layer structure (43), and a thermally transferable protective layer formed on the thermally transferable

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release layer, the thermally transferable protective layer having a single or multi-layer structure, and comprising a thermoplastic resin having a storage modulus at 110°C of  $1 \times 10^5$  Pa or less (44, see Figure 1b, and column 7, lines 31-36). However, Mohri et al. does not disclose an adhesive layer.

14. Saito et al. (6,346,316) discloses a protective layer transfer sheet, including a thermally transferable adhesive (14) layer formed on the thermally transferable protective layer, the thermally transferable adhesive layer having a single-or multi-layer structure (See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the adhesive layer of Saito et al.

(6,346,316) with the receiving sheet disclosed by Mohri et al. The motivation would have been to facilitate the transfer of the protective layer (column 8, lines 33-34).

Therefore, it would have been obvious to combine Saito et al. (6,346,316) with Mohri et al. to obtain the invention as disclosed in claim 40.

15. As to claim 41, Mohri et al. discloses the substrate sheet is formed of a plastic film having a thickness from 2 to 100  $\mu\text{m}$  (column 9, lines 14-22).

16. As to claim 43, Mohri et al. discloses a portion of the transfer sheet to be transferred provides a coverage of 3 to 30  $\text{g/m}^2$  (column 30, lines 27-29).

17. As to claim 44, Mohri et al. discloses the thermoplastic resin has a  $T_g$  value of 40°C to 100°C (i.e. polyvinyl chloride, column 9, lines 26-33).

18. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,312,788 to Mohri et al. in view of U.S. Patent No. 6,346,316 to Saito et al.

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as applied to claims 40-41, and 43-44 above, and further in view of U.S. Patent No. 5,726,122 to Saito et al.

19. With respect to claim 42, Mohri et al. and Saito et al. (6,346,316) disclose a receiving sheet, including a protective layer (42). However, Mohri et al. and Saito et al. (6,346,316 ) do not disclose a glossiness value for the transfer sheet. Saito et al. (5,726,122) discloses the plastic film has a glossiness at 45 degrees of 100% or less (See Example B-1, Table 6, and column 28, lines 53-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the glossiness measurement of Saito et al. (5,726,122) with the receiving sheet disclosed by Mohri et al. and Saito et al. (6,346,316). The motivation would have been to form images that are clear and excellent in transparency (column 1, lines 38-39). Therefore, it would have been obvious to combine Saito et al. (5,726,122) with Mohri et al. and Saito et al. (6,346,316 ) to obtain the invention as disclosed in claim 37.

### ***Response to Arguments***

20. Applicant's arguments filed March 30<sup>th</sup>, 2006 have been fully considered, all rejections/objections have been withdrawn.

21. In light of the cancellation of claim 27, the objection to claim 27 is withdrawn.

22. The rejection of claim 19 under U.S.C. 112 second paragraph is withdrawn due to amendment. However, a new rejection under U.S.C. 112 second paragraph has been issued.

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23. In light of the cancellation of claim 27, the rejection of claim 27 under U.S.C. 102(e) has been withdrawn.

24. In view of the amendment of claim 19, the rejection of claim 19 under U.S.C. 102(e) has been withdrawn. A new 102 rejection has been issued.

25. Applicant's arguments with respect to claims 19 and 36-44 have been considered but are moot in view of the new ground(s) of rejection.

26. This application contains claims 20-26 and 28 drawn to an invention nonelected with traverse in the response filed October 20<sup>th</sup>, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kim McClelland*

KKM

*Linda L Gray*  
**LINDA GRAY**  
**PRIMARY EXAMINER**